



JFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/560,194

Confirmation No.:

Applicant(s): Tai et al.

Filed: 06/10/2004

Art Unit:

Examiner:

Title: Receptacle Connector Assembly For IC Card and IC Card Connector

Attorney Docket No.: 003D.0083.U1(US)

Customer No.: 29,683

Mail Stop Petitions  
Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Petition To Commission  
(37 C.F.R. §1.181)

Sir:

This is a petition under 37 C.F.R. §1.181 to invoke the supervisory authority of the Commissioner.

**Statement Of Facts**

1. A Notification of Missing Requirements was mailed by the USPTO on 03/15/2006.
2. In response to that Notice on 4/7/2006 the undersigned filed:
  - a. a Declaration signed by two of the three inventors; and
  - b. a Petition under 37 C.F.R. 1.47(a) regarding the third non-signing inventor.
3. On 8/3/2006 a Decision was mailed by the USPTO denying the Petition.

4. On 9/20/2006 a Renewed Petition under 37 C.F.R. 1.47(a) was filed with additional evidence.
5. On 1/12/2007 a Decision was mailed by the USPTO denying the Renewed Petition.

### **Point To Be Reviewed**

Is the Attorney Advisor in the Office of PCT Legal Administration correct in denying applicants' Petition and Renewed Petition under 37 C.F.R. 1.47(a)?

### **Action Requested**

The Commissioner is requested to direct the Attorney Advisor in the Office of PCT Legal Administration to grant the Petition under 37 C.F.R. 1.47(a).

### **Discussion**

In the present case, it appears that the Attorney Advisor in the Office of PCT Legal Administration has taken an overly restrictive requirement regarding factual proof which is required under 37 C.F.R. 1.47(a); that the inventor refuses to execute the application or cannot be reached after diligent effort.

37 C.F.R. 1.47(a) states:

"If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(g), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63."

MPEP 409.03(d) relates to Proof of Unavailability or Refusal. In this case it is not known if the inventor is unavailable or if the inventor is refusing to sign the declaration. These are the facts:

- On February 7, 2006 a letter was sent by the undersigned to the non-signing inventor at his last known address. A copy of that letter was submitted as an Exhibit. The letter and documents referred to in the letter were sent to the non-signing inventor via Federal Express with a pre-paid return envelope. The documents included a copy of the application as filed including a copy of the specification, claims and drawings. No reply was received to that letter.
- The Attorney Advisor in the Office of PCT Legal Administration considered this evidence (the inventor's failure to respond to a single mailing, receipt of which has not been confirmed) to be insufficient to conclude that the inventor has refused to sign the application. The Attorney Advisor in the Office of PCT Legal Administration later admitted (in the Decision mailed 1/12/2007) that multiple mailings are not necessarily required to satisfy the prerequisite to claiming a refusal to sign by the inventor.
- To gather further evidence for the Attorney Advisor, applicants' attorney sent the non-signing inventor another letter on August 8, 2006; again requesting the inventor to sign the declaration. A copy of that letter has been filed as evidence that the non-signing inventor is unavailable or is refusing to sign the declaration. No reply has been received to that letter from the non-signing inventor.

- In the Decision mailed 1/12/2007 the Attorney Advisor in the Office of PCT Legal Administration stated:
  1. That the petitions did not include any confirmation that the non-signing inventor received the mailing (i.e., a signed receipt).
  2. That the petitions referred to an express statement of refusal from the inventor to an unnamed former co-worker, but no first hand evidence was provided with respect to this assertion.
  3. That the petitions did not include evidence to confirm that the address being used for the non-signing inventor is current.
  4. That failure of the inventor to respond to mailings requesting him to sign the declaration, absent additional evidence, cannot constitute a constructive refusal to sign.
  5. That the present record can just as readily be interpreted as showing that the inventor no longer resides at this address, in which case evidence of a diligent effort to locate the inventor's current address is necessary.

The Attorney Advisor has clearly imposed overly burdensome and unnecessary requirements on the applicants which are not required by 37 C.F.R. 1.47(a) or MPEP 409.03(d). The faults with each one of these requirements and findings are discussed separately below:

1. In regard to Item 1, neither 37 C.F.R. 1.47(a) nor MPEP 409.03(d) require confirmation that the non-signing inventor received the mailing (i.e., a signed receipt). All that is required is that a diligent effort be made to

find or reach the non-signing inventor, such as a mailing being sent to the last known address. This is further clarified by MPEP 409.03(d) which states "A copy of the application papers should be sent to the last known address of the nonsigning inventor...." Neither of the mailings sent to the non-signing inventor have been returned, so it is reasonable to assume that they were delivered. Because they were not returned, it is unreasonable to assume that they were not delivered to the inventor. Requiring proof of "receipt" of the mailings by the non-signing inventor is an unnecessary and unreasonable requirement imposed by the Attorney Advisor.

2. In regard to Item 2, the first filed petition stated that:

"Based upon information and belief, prior to mailing of the letter noted above, a copy of the declaration was delivered to the wife of the non-signing inventor and delivered to the non-singing inventor by his wife. In a subsequent telephone conversation with a former co-worker, the non-signing inventor indicated that he would not sign the declaration."

Although it was known from MPEP 409.03(d) that statements based on hearsay will not normally be accepted. This evidence was submitted to present a complete record of the facts and not withhold evidence from the USPTO. This evidence was submitted to fulfill the requirement of MPEP 409.03(d) that:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

Although MPEP 409.03(d) requires that "Where a refusal of

the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made." In this case the oral refusal was not made by the person who presented the inventor with the application papers (the undersigned attorney through mailings).

Even if the USPTO ignores this evidence, failure to supply first hand knowledge of this evidence should not be used to deny the Petition when the rest of the evidence is sufficient to grant the Petition. Again, this evidence was submitted to present a complete record of the facts and not withhold evidence from the USPTO even though the undersigned knew that statements based on hearsay will not "normally" be accepted.

3. In regard to Item 3, neither 37 C.F.R. 1.47(a) nor MPEP 409.03(d) require evidence to confirm that the address being used for the non-signing inventor is current. All that is required is specifying the last known address and "A copy of the application papers should be sent to the last known address of the nonsigning inventor...." This has been done in this case. Requiring additional proof that the address being used for the non-signing inventor is current is an unnecessary and unreasonable requirement imposed by the Attorney Advisor. In addition, neither 37 C.F.R. 1.47(a) nor MPEP 409.03(d) require evidence of receipt of any confirmation of the accuracy of the address. Requiring additional proof of receipt of any confirmation of the accuracy of the address is an unnecessary and unreasonable requirement imposed by the Attorney Advisor.

4. In regard to Item 4, the Attorney Advisor stated that the

failure of the inventor to respond to mailings requesting him to sign the declaration, absent additional evidence, cannot constitute a constructive refusal to sign. This is clearly an error. This is not a case, such as in In re Harding et al., 211 USPQ 903 (Comm'r Pat. 1980), where no attempt to contact the non-signing inventor was made. In fact, MPEP 409.03(d) clearly states that "A copy of the application papers should be sent to the last known address of the nonsigning inventor...." This is precisely what has been done in this case. For the Attorney Advisor to state that failure of the inventor to respond to mailings requesting him to sign the declaration, absent additional evidence, cannot constitute a constructive refusal to sign appears to be in direct contradiction to MPEP 409.03(d). The Commission is requested to clearly hold that failure of the inventor to respond to a mailing requesting him to sign the declaration, absent additional evidence, can constitute a constructive refusal to sign.

5. In regard to Item 5, the Attorney Advisor stated that that the present record can just as readily be interpreted as showing that the inventor no longer resides at this address, in which case evidence of a diligent effort to locate the inventor's current address is necessary. The Attorney Advisor is using his imagination to create facts which are not in the record. To follow the Attorney Advisor reasoning, the present record can just as readily be interpreted as showing that:

- The non-signing inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration; or
- The non-signing inventor is hospitalized and/or is not conscious; or

- The non-signing inventor is dead.

However, there is no evidence of any of these circumstances in the record. The mailings sent to the inventor were not returned as undeliverable nor returned with an indication that the inventor is no longer located at that address. Therefore, it is reasonable to assume (absent further evidence that the inventor no longer resides at this address) that the inventor still resides at that address. There is no requirement under 37 C.F.R. 1.47(a) or MPEP 409.03(d) for the petitioner to prove that the last known address of the inventor is still the current address of the non-signing inventor. In this case the applicants' have no knowledge or information that the last known address of the inventor is not still the current address of the inventor.

Requiring additional proof that the non-signing inventor still resides at the last known address (where there is no evidence to indicate that the non-signing inventor no longer resides at the last known address) is an unnecessary and unreasonable requirement imposed by the Attorney Advisor.

In this case, the last known address is in Taiwan. Unlike a situation where a non-signing inventor is in the U.S. (where it would be relatively easy to conduct an internet search(es) and perhaps attempt telephone calls) there are potential language differences (English versus Chinese) which make such search(es) and telephone calls difficult in Taiwan from the U.S. Finding the inventor would perhaps require hiring a private detective in Taiwan to track down the non-signing inventor. This is clearly not what "diligent effort" in 37 C.F.R. 1.47(a) requires. A diligent effort is required; **not an extra-ordinary effort**. Sending two mailings to the non-signing inventor's last known address, where neither one of those mailings was returned as being undeliverable or indicating that the non-signing

inventor had moved, is a diligent effort. Therefore, the applicants' have satisfied the requirements of 37 C.F.R. 1.47(a).

Attached are copies of receipts from Federal Express, but they do not show receipt by the non-signing inventor. They merely show signed receipt by people at the non-signing inventor's address on behalf of the non-signing inventor. In any event, such receipts should not be required for a Petition under 37 C.F.R. 1.47(a).

#### Summary

As noted above, at the present time it is not known if the non-signing inventor is unavailable or if the non-signing inventor is refusing to sign the application papers. However, multiple attempts have been made to present the non-signing inventor with the application papers for execution. There has been no evidence that the non-signing inventor has not received those mailing. Thus, this establishes constructive proof that the inventor is unavailable or that the inventor is refusing to sign the application papers. The applicants' have satisfied the requirements of 37 C.F.R. 1.47(a). The Commissioner is requested to reverse the decision of the Attorney Advisor and order that the Petition under 37 C.F.R. 1.47(a) be granted.

From past experiences in filing Petitions under 37 C.F.R. 1.47(a) and MPEP 409.03(d), it is an observation of the undersigned that the PCT branch of the USPTO appears to be using a more stringent and over-burdensome proof requirement than the non-PCT units of the USPTO. The Commissioner is requested to insure that both PCT applications and non-PCT applications are treated with the same requirements under 37 C.F.R. 1.47(a) and MPEP 409.03(d), while taking into account the difficulties in obtaining proof and using diligent efforts when

a non-signing inventor is located outside the U.S.

Respectfully submitted,

Mark F. Harrington  
Mark F. Harrington (Reg. No. 31,686)

1/24/07

Date

**Customer No.: 29683**  
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January 24, 2007



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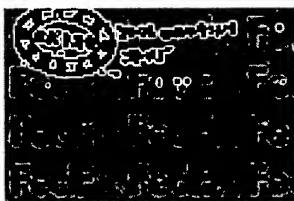
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January 24, 2007



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